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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,908	09/18/2003	Dennis M. Godek	PC9940D	8523

28523 7590 07/12/2004  
PFIZER INC.  
PATENT DEPARTMENT, MS8260-1611  
EASTERN POINT ROAD  
GROTON, CT 06340

EXAMINER
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PESELEV, ELLI

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/666,908

Applicant(s)

GODEK ET AL.

Examiner

Elli Peselev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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The disclosure is objected to because of the following informalities: page 1 of the specification fails to set forth the status of the parent applications.

Appropriate correction is required.

Claims 1-5 and 15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating bacterial or protozoal infections with macrolide antibiotics erythromycin, clarithromycin, azithromycin, josamycin and tylosin, does not reasonably provide enablement for treating cancer with said antibiotics. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The macrolide antibiotics erythromycin, clarithromycin, azithromycin, josamycin and tylosin are not known to be useful for the treatment of cancer. Since the specification fails to provide any evidence that the claimed methods are useful for treating cancer and in view of high unpredictability in the treatment of cancer, there is a good reason to doubt that the claimed methods are effective in the treatment of cancer.

Claims 6-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating emesis, does not reasonably provide enablement for preventing emesis. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The term "preventing" encompasses administering the effective composition to a healthy host and preventing said host from ever getting emesis i.e. it reads on vaccine. Since a substance P

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antagonist is not known to be useful as vaccine, there is a good reason to doubt that the claimed methods are effective in preventing emesis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 11, 12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagan et al (U.S. Patent No. 5,547,964).

Hagan et al disclose the treatment of cancer with a combination of substance P antagonist with anticancer agents such as macrolide doxorubicin (column 1).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macy et al (U.S. Patent No. 5,958,888) or Schadelwald et al (U.S. Patent No. 5,468,735) in combination with applicant's admittance on page 1 of the specification.

Each of Macy et al and Schadelwald et al discloses macrolide antibiotics to be useful for the treatment of a broad range of infections. Applicants admit on page 1 of the specification that at the time the instant invention was made it was well known in the art that macrolide antibiotics can cause emesis. Hagan et al disclose that substance P antagonists are useful for the treatment of emesis however induced including emesis caused by various drugs including anticancer agents (column 1, lines 56-65).

Therefore, a person having ordinary skill in the art at the time the instant invention was made would have been motivated to treat emesis caused by with substance P antagonists as set forth in claims 6-10 and to combine substance P antagonists with macrolide antibiotics in order to treat infections and emesis caused by said antibiotics.

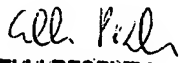
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (571) 272-0659. The examiner can normally be reached on 9.00-5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elli Peselev

  
**ELLI PESELEV**  
**PRIMARY EXAMINER**  
**GROUP 1200**